

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: DORSEY & WHITNEY LLP  
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WASHINGTON D.C. 20004

## PCT

WRITTEN OPINION

(PCT Rule 66)

Date of Mailing  
(day/month/year) **05 SEP 2001**

Applicant's or agent's file reference  
**5289.01**

REPLY DUE  
within TWO months  
from the above date of mailing

International application No.  
**PCT/US00/29813**

International filing date (day/month/year)  
**27 OCTOBER 2000**

Priority date (day/month/year)  
**27 OCTOBER 1999**

International Patent Classification (IPC) or both national classification and IPC  
**IPC(7): H04N 7/173 and US Cl.:725/87**

Applicant  
**DISCOVERY COMMUNICATIONS INC.**

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☒ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(4).~~

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.  
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: **27 FEBRUARY 2002**

Name and mailing address of the IPEA/US  
Commissioner of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

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Authorized officer

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*Robert Ward*  
**DOCKETED**  
9-12-01  
Wen

## WRITTEN OPINION

International application No.

PCT/US00/29813

## I. Basis of the opinion

## 1. With regard to the elements of the international application:\*

- ☒ the international application as originally filed  
the description:  
pages 1-89, as originally filed  
pages NONE, filed with the demand  
pages NONE, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
pages 90-102, as originally filed  
pages NONE, as amended (together with any statement) under Article 19  
pages NONE, filed with the demand  
pages NONE, filed with the letter of \_\_\_\_\_
- ☒ the drawings:  
pages 1-53, as originally filed  
pages NONE, filed with the demand  
pages NONE, filed with the letter of \_\_\_\_\_
- ☒ the sequence listing part of the description:  
pages NONE, as originally filed  
pages NONE, filed with the demand  
pages NONE, filed with the letter of \_\_\_\_\_

## 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

## 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

- ☐ contained in the international application in printed form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages NONE  
☒ the claims, Nos. NONE  
☒ the drawings, sheets/fig. NONE

5. ☐ This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".

WRITTEN OPINION

International application No.

PCT/US00/29813

VI. Certain documents cited

1. Certain published documents (Rule 70.10)

| <u>Application No.<br/>Patent No.</u> | <u>Publication Date<br/>(day/month/year)</u> | <u>Filing Date<br/>(day/month/year)</u> | <u>Priority date (valid claim)<br/>(day/month/year)</u> |
|---------------------------------------|--|---|---|
| US A 6,052,717                        | 18 APRIL 2000                                | 23 OCTOBER 1996                         |   |
| US A 6,034,680                        | 07 MARCH 2000                                | 30 APRIL 1997                           | 25 APRIL 1997   |

2. Non-written disclosures (Rule 70.9)

| <u>Kind of non-written disclosure</u> | <u>Date of non-written disclosure<br/>(day/month/year)</u> | <u>Date of written disclosure<br/>referring to non-written disclosure<br/>(day/month/year)</u> |
|---------------------------------------|--|--|
|                                       |  |  |

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

**TIME LIMIT:**

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

**V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):**

Claim 71 lacks an inventive step under PCT Article 33(3) as being obvious over Hendricks.

Considering claim 71, Hendricks discloses all the claimed subject matter above, except for the Internet Web site as recited in the claim.

It is notoriously well known in the art that the Internet is the most widely used source of information.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' system to include an Internet Web site because the Internet is the most widely used source for obtaining information.

Claims 1-17, 38-47 and 49-60 meet the criteria set out in PCT Article 33(2)-(4), because the prior art does not teach or fairly suggest a method and corresponding apparatus for distributing electronic books to subscribers comprising storing electronic books, receiving book orders, determining a queue location, placing first and second sections in first and second queues or receiving electronic books, placing or more books in a plurality of queues and emptying the queues in accordance with a priority model as recited in the claims.

**----- NEW CITATIONS -----**

WO 95 15649 A (HENDRICKS et al.) 08 June 1995, figures 10-12.

US, 4,855,725 A (FERNANDEZ) 08 August 1989, abstract figures 1-3

WRITTEN OPINION

International application No.

PCT/US00/29813

**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. statement**

|                               |                                      |     |
|-------------------------------|--------------------------------------|-----|
| Novelty (N)                   | Claims <u>1-17, 38-47, 49-60, 71</u> | YES |
|                               | Claims <u>18-37, 48, 61-70</u>       | NO  |
| Inventive Step (IS)           | Claims <u>1-17, 38-47, 49-60</u>     | YES |
|                               | Claims <u>18-37, 48, 61-71</u>       | NO  |
| Industrial Applicability (IA) | Claims <u>1-71</u>                   | YES |
|                               | Claims <u>NONE</u>                   | NO  |

**2. citations and explanations**

Claims 18-37, 48 and 61-70 lack novelty under PCT Article 33(2) as being anticipated by Hendricks et al. (WO 95 15649).

Considering claim 18, Hendricks discloses a method for delivering electronic books in an electronic book delivery system comprising:

- a) storing main sections of electronic books (index or titles stored at the library 262 as disclosed throughout the reference including but not limited to pages 18-19 and figure 10);
- b) receiving a request for a main section of an electronic book (figure 10, step 700);
- c) locating the requested main section (figure 10, step 708); and
- d) providing the located main section (figure 10, step 712).

Claims 19-27 are met by figure 10 and pages 18-19, wherein the auxiliary sections are the pages of a book.

Considering claims 28, 48 and 61, Hendricks discloses a method for delivering electronic books in an electronic book delivery system comprising:

- a) storing first sections (index or titles) at the library (262) or at the operations center (250) as disclosed throughout the reference including but not limited to pages 18-19 and figure 10);
- b) storing second sections (pages of the book) at the library (262) or at the operations center (250) as disclosed throughout the reference including but not limited to pages 18-19 and figure 10);
- c) receiving a request for an electronic book (figure 10, step 716);
- d) retrieving a second section (i.e. the pages of the book); and
- e) providing the located main section (figure 10, step 720).

Claims 29-37 and 62-70 are met by figures 1-10.

(Continued on Supplemental Sheet.)